

Serial No. 10/734,815

Art Unit: 1744

Remarks

Claims 1-18 are currently pending in the above-captioned matter.
Reconsideration is respectfully requested in view of these remarks.

35 USC §103 Rejections

Claims 1-6, 9-11, 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. (US 6,146,473) in view of Ahmed et al. (US 5,239,002). Applicants respectfully traverse the rejection and submit that the Patent Office has not met its burden of establishing a prima facie case of obviousness.

As the Patent Office is aware, in order to support a rejection under 35 U.S.C. §103, the Office must establish that there was some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability, and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q. 2d (BNA) 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The '473 patent is directed to forming coatings on aluminum cans which requires the presence of an acrylic resin having a N-heterocyclic ring and at least one of Zr, Mo, W, Nb, Ni, Co, Mn and Ta, and optionally phosphoric acid or phosphate. There is no teaching or suggestion of Applicants' claim 1 feature that the solution be free of divalent metals when phosphoric acid or anions of phosphoric acid is present. The '427 also teaches the use of Ni which is contrary to Applicants' claim 13 reciting a nickel free method. The '427 appears to require that the acrylic monomer, N-heterocyclic monomer and other monomers be copolymerized. The monomers named as suitable in the '427 patent for the N-heterocyclic ring source include N-vinyl pyrrolidine, vinyl pyridine, N-vinyl imidazole, but not N-vinyl pyrrolidone.

Serial No. 10/734,815

Art Unit: 1744

There is no teaching or suggestion in the '473 patent that N-vinyl pyrrolidone could be substituted as a suitable monomer. To one of ordinary skill in the art, N-vinyl pyrrolidone does not belong to the group recited in the '473 patent since it contains an oxygen and all of the molecules named as suitable for in the '437 patent are oxygen free. Reading the group of suitable N-heterocyclic ring molecules of '473 would not lead one of ordinary skill in the art to use pyrrolidone. Thus, the '473 fails to teach or suggest the combination of features found in independent claims 1 or 13, and the claims depending therefrom, and actually teaches away.

The '002 reference fails to remedy the deficiencies of the '473 patent. The '002 patent teaches improving the adhesion of a beneficiary polymer to copper by applying an undercoat of a second polymer or by mixing the two polymers. The beneficiary polymer is a sulfur containing polymer and the second polymer is heterocyclic nitrogen containing polymer. There is no teaching or suggestion that the heterocyclic nitrogen containing polymer can be used alone. The '002 patent asserts that the polymer coating provides corrosion resistance, but a review of the Examples shows that the corrosion resistance is on a lesser scale than Applicants. Table VI of the '002 patent shows that copper panels were heated in the presence of PPS for 48 hours. In comparison, Applicants scribed cold rolled steel (CRS) and galvanized panels and then exposed them to salt spray for 21 days (equates to 504 hours). One of ordinary skill in the art, seeking corrosion protection of 21 days would not be motivated to use polymers of the '002 patent. Although the Office may suggest that the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such modification. *In re Laskowski* 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989). There is no such suggestion and it would not be obvious to one of skill in the art to modify the '473 patent by adding already polymerized N-vinylpyrrolidone of the '002 patent instead of copolymerizing acrylic monomers with oxygen-free N-heterocyclic monomers. Even if this were done, it would not achieve Applicants' claimed invention.

Serial No. 10/734,815**Art Unit: 1744**

Claims 7, 8, 12, 14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. and Ahmed et al. as applied to claim 1 and further in view of Steinbrecher et al (WO 96/27034). The arguments made with regard to the rejection of independent claims 1 and 13 are incorporated herein by reference. The '034 publication does not remedy the deficiencies of the other references and the claims are patentable over said references.

Claims 1-4, 7, 8 and 10-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12, 26-28, 31, 32, 35 and 36 of copending Application No. 10/203,150. Applicant acknowledges the provisional rejection. Applicant submits that the applications are owned by the same entity, and proposes to file a terminal disclaimer in the event that the provisional rejection becomes a non-provisional rejection.

Serial No. 10/734,815
Art Unit: 1744

Conclusion

Applicants request reconsideration in view of the amendments and remarks contained herein. Applicants submit that the claims are in condition for allowance and a notice to that effect is respectfully requested. Should the Examiner have any questions regarding this paper, please contact the undersigned

Respectfully submitted,



Mary K. Cameron
(Reg. No. 28,789)
Attorney for Applicants
248-589-4672

Henkel Corporation Law Department
2200 Renaissance Blvd., Suite 200
Gulph Mills, PA 19406